

REMARKS

By this Amendment, Applicants amend claims 1, 18, and 20 to more appropriately define the present invention and cancel claim 17 without prejudice or disclaimer of the subject matter thereof. No new matter is added. Claims 1-16 and 18-21 are pending in this application.

In the Office Action dated October 24, 2003, the Examiner rejected claims 1-21 under 35 U.S.C. § 102(b) as anticipated by Schipper (U.S. Patent No. 5,815,118) and rejected claims 2, 6, 9 and 11-14 under 35 U.S.C. § 103(a) as unpatentable over Schipper in view of DeLorme et al. (U.S. Patent No. 5,848,373).

Applicants thank the Examiner for the courtesies extended to Applicants' representative during a telephone interview held on January 22, 2004. During the interview, Applicants' representative and the Examiner discussed the pending claims and the cited prior art in the Office Action dated October 24, 2003.

Applicants respectfully traverse the rejection of claims 1-21 under 35 U.S.C. § 102(b) as anticipated by Schipper for at least the following reasons.

To properly anticipate Applicants' claimed invention under 35 U.S.C. § 102(b), the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

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Claim 1 recites a combination including, among other things, "a map processing platform in communication with the map display, wherein said map processing platform is adapted to: receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location." Schipper fails to teach a combination including at least these elements of claim 1. Since Schipper does not teach each and every element of claim 1, it cannot anticipate claim 1.

In the Response to Amendment section of the Office Action (page 2), the Examiner alleges Schipper "teaches an interactive automated mapping system that uses location information determined using a GPS is disclosed by Mauney et al. in U.S. Pat. No. 5,214,757. Attributes related to location information can be entered, stored and subsequently displayed. The system creates new maps and/or annotates existing maps. Therefore the step of claim 1 should be inherent." Applicants respectfully disagree.

First, this disclosure of Schipper does not teach at least "a map processing platform in communication with the map display, wherein said map processing platform is adapted to: receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location," as recited in claim 1. In particular, the passage cited by the Examiner merely discloses that attributes relating to location information obtained from a GPS system can be entered, stored, and displayed on a map. Further, the passage cited by the Examiner discloses that the "system creates new maps and/or annotates existing maps but does not provide reconciliation between

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an existing map and a new map" (col. 4, lines 11-13) (emphasis added). In fact, this passage teaches away from the elements recited in claim 1. In other words, this passage merely discloses that GPS information can be displayed or added as an annotation to a particular existing map or a particular new map, but does not provide reconciliation between maps. In contrast, claim 1 recites at least a map processing platform adapted to "receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location." Accordingly, Schipper fails to anticipate claim 1.

Second, contrary to the Examiner's allegations, the elements of claim 1 are not inherent in Schipper's disclosure. To establish inherency, the Examiner must specifically identify extrinsic evidence that makes clear to one skilled in the art that the missing element "is necessarily present" in the Schipper disclosure. *See id.*; *see also Continental Can Co. v. Monsanto. Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). The Examiner has not indicated any extrinsic evidence that makes it clear to one skilled in the art that Schipper necessarily includes all elements of claim 1. Claim 1 recites at least a map processing platform adapted to "receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location." The Examiner has made an unsupported conclusion regarding Schipper and has not pointed to any extrinsic evidence that makes it clear to one skilled in the art that these elements are necessarily present in Schipper.

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In addition, in the Claim Rejections section of the Office Action (page 4), the Examiner, in citing col. 6, lines 24-30 of Schipper, further alleged that the "step of manipulated or annotated is inherent, because at a location on the first map (old map) will update a second map (new map)." Applicants respectfully disagree. Schipper discloses that location coordinates of two or more landmarks from an old map 109 are entered into a computer 111 using a keyboard or other data entry device 113. (See col. 30, lines 3-6). The location coordinates are the user's relative bearings to the two or more landmarks. Once the Schipper device receives the user-inputted coordinates, it uses those coordinates and the user's location as computed by an LDS, to depict the user's location on a map. Schipper thus does not teach at least a map processing platform that is adapted to "receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location," as recited in claim 1. Nor at these features inherently disclosed in Schipper, contrary to the Examiner's allegations.

The Examiner also alleges in the Response to Amendment section (page 3) that Schipper "reconciles possibly inconsistent information provided by the old map and by the LDS coordinates" by an approach described at col. 5, lines 20-33. Schipper discloses that when a location fix is needed, the user obtains LDS-based range and azimuth measurements from the present user location to two, three, four or more selected physical landmarks for which location coordinates are available on the old map. This information is used to estimate the user's location on the old map. In other words, measurements from the user's physical location are taken in relation to physical landmarks to determine the user's location on the old map. In contrast, claim 1 recites a

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combination including, among other things, "a map processing platform in communication with the map display, wherein said map processing platform is adapted to: receive a user annotation at a first location on a first map and simultaneously update a second map with the user annotation at a location on the second map that corresponds to said first location." Accordingly, Schipper fails to anticipate claim 1.

For at least the above reasons, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 102(b). Claims 2-16 and 21 depend directly or indirectly from claim 1 and are thus allowable at least due to their dependence from allowable claim 1. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 2-16 and 21 under 35 U.S.C. § 102(b).

Claims 18 and 20 recite combinations of elements including, "detecting an annotation entry on the first map," "associating the annotation entry with a set of first map coordinates," "associating the set of the first map coordinates with a set of second map coordinates," and "upon detecting the annotation entry, simultaneously enabling the display of the annotation entry on the second map." Schipper does not disclose at least these features.

In rejecting claims 18 and 20, the Examiner has applied the same rationale used to reject claim 1. For at least the above reasons discussed above, Schipper does not disclose or suggest at least "detecting an annotation entry on the first map," "associating the annotation entry with a set of first map coordinates," "associating the set of the first map coordinates with a set of second map coordinates," and "upon detecting the annotation entry, simultaneously enabling the display of the annotation entry on the second map," as recited in claims 18 and 20. Claim 19 depends from claim 18.

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Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 18-20 under 35 U.S.C. § 102(b).

Finally, because Applicants have canceled claim 17 without prejudice or disclaimer of the subject matter thereof, the rejection of claim 17 is thus moot.

Applicants respectfully traverse the rejection of claims 2, 6, 9 and 11-14 under 35 U.S.C. § 103(a) as unpatentable over Schipper in view of DeLorme.

To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate each of three requirements. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, not in applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

As discussed above, Schipper does not disclose or suggest each of the elements of claims 1-21. Claims 2, 6, 9, and 11-14 each include the recitations of their respective base claims. DeLorme disclose a computer aided map location system (CAMLs) that provides correlation and coordination of spatially related data between a computer and a set of printed maps typically printed on paper depicting surface features at desired levels of detail. DeLorme does not make up for the deficiencies of Schipper. Schipper and DeLorme, either taken alone or in combination, thus do not disclose or suggest

claims 2, 6, 9, and 11-14. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 2, 6, 9, and 11-14 under 35 U.S.C. § 103(a).

CONCLUSION

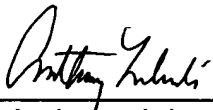
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 26, 2004

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